

Serial No. 10/726,461
Attorney Docket No. 24170759.2

REMARKS/ARGUMENTS

Claims 1-50 were originally filed in the present Application. In response to a Restriction Requirement, claims 26-50 were withdrawn from consideration at this time. By prior Amendment, claims 1, 12-14, 19, and 22-23 were amended, and by the present Amendment claims 1 and 14 are again amended. Accordingly, claims 1-25 remain pending in the present Application, and Applicants assert their condition for allowance over the prior art for at least the reasons set forth in the Amendments, as well as reasons set forth below, and thus respectfully request reconsideration of the rejected claims.

I. REJECTIONS UNDER 35 U.S.C. §102

The Examiner rejected claims 1-4, 7, 14-15 and 20 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,439,726 to Woiceshyn. The Examiner also rejected claims 1, 7, 9-10, 14 and 18-19 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,151,146 to Green. The Applicants have amended independent claims 1 and 14 to recite that the first and second layers of the nonwoven fibers are in physical contact. Neither Woiceshyn nor Green expressly or inherently disclose each element in amended independent claims 1 and 14. Thus, the Applicants respectfully request that the Examiner withdraw the § 102(b) rejections with respect to claims 1-4, 7, 14-15 and 20 in view of Woiceshyn, and also the § 102(b) rejections with respect to claims 1, 7, 9-10, 14 and 18-19 in view of Green.

Commercial products, such as napkins, gowns, towels, clothes, and fabrics, can be made with woven and nonwoven materials. The amount of woven and nonwoven material will determine the strength and utility of each product. Woiceshyn discloses the use of a first, second, and third layer and a bituminous material (Abstract and see Figure 7). The Examiner equates Woiceshyn's first layer 1 of fabric comprising two sets of fibers dispersed in two different direction (Col. 2, lines 58-65 and Abstract) to Applicants' "first layer of directionally

Serial No. 10/726,461
Attorney Docket No. 24170759.2

aligned nonwoven fibers.” The Examiner further equates Woiceshyn’s third layer of porous fiberglass mat 12 (Col. 3, lines 40-60 and Abstract) to Applicants’ “second layer of randomly dispersed nonwoven fibers.” Then, the Examiner states that the fiberglass mat 12 is over the first layer 1 as recited in claims 1 and 14 of the present Application. In response, the Applicants have amended independent claims 1 and 14 to more clearly recite that the first and second layers of the nonwoven fibers are in physical contact when the second layer is located over the first layer. As such, Woiceshyn does not disclose each element of amended independent claims 1 and 14.

Woiceshyn teaches an additional second layer 5 of reinforcing fabric (Col. 3, lines 13-17 and Abstract) formed in between the first layer 1 and the fiberglass mat 12. This second layer 5 material is essential to Woiceshyn’s reinforced bituminous roofing membrane because it allegedly provides high strength and open grid reinforcement, and thus reduces the product’s tendency to delaminate (Col. 3, lines 13-27). Accordingly, there is no motivation or suggestion to remove the second layer 5 material from Woiceshyn’s reinforced bituminous roofing membrane since it plays an express purpose in his product design. Since the intermediate layer (second layer 5) is not a nonwoven layer in physical contact with a first nonwoven layer, as recited in claims 1 and 14, Woiceshyn does not expressly or inherently disclose each element of independent claims 1 and 14, as amended. In addition, the remaining claims rejected as anticipated by Woiceshyn (claims 2-4, 7, 15 and 20) are also patentably distinct since they each depend from either amended independent claims 1 or 14. Accordingly, the Applicants respectfully request that the Examiner withdraw the § 102(b) rejections in view of Woiceshyn with respect to the pending claims.

Likewise, the Applicants respectfully request that the Examiner withdraw the § 102(b) rejections with respect to claims 1, 7, 9-10, 14 and 18-19 in view of Green based on similar

Serial No. 10/726,461
Attorney Docket No. 24170759.2

arguments as those discussed above. Green discloses the mating of at least two plies of fiberglass scrim fabric to form a roofing laminate (Abstract). The Examiner equates Green's triaxially wound fiberglass 20 (Col. 2, lines 1-8) to Applicants' "first layer of directionally aligned nonwoven fibers." The Examiner further equates Green's web of nonwoven fiberglass 28 to Applicants' "second layer of randomly dispersed nonwoven fibers." Then, the Examiner states that the web of nonwoven fiberglass 28 is formed over the triaxially wound fiberglass 20 via an adhesive 36 (Col. 3, lines 40-50), as recited in claims 1 and 14. As discussed above, the Applicants have amended independent claims 1 and 14 to more clearly recite that the first and second layers of the nonwoven fibers are in physical contact when the second layer is located over the first layer. As such, Green also does not disclose each element of amended independent claims 1 and 14.

Green teaches an additional warp yarn 24 (Col. 2, lines 7-10, 34-43, and Figures 5 and 6) formed in between the triaxially wound fiberglass 20 and the web of nonwoven fiberglass 28. This warp yarn 24 material is essential to Green's roofing laminate because it provides resistance in preventing the triaxially wound fiberglass 20 from distorting in different directions. There is no motivation in Green to remove this warp yarn 24, since nothing else is disclosed or suggested that would maintain the order and structure of the triaxially wound fiberglass 20 (Col. 2, lines 43-53). Since the warp yarn 24 is not a nonwoven layer in physical contact with a first nonwoven layer, as recited in claims 1 and 14, Green also does not expressly or inherently disclose each element of independent claims 1 and 14, as amended. In addition, the remaining claims rejected as anticipated by Green (claims 7, 9-10 and 18-19) are also patentably distinct since they each depend from either amended independent claims 1 or 14. Accordingly, the

Serial No. 10/726,461
Attorney Docket No. 24170759.2

Applicants respectfully request that the Examiner withdraw the § 102(b) rejections in view of Green with respect to the pending claims.

II. REJECTIONS UNDER 35 U.S.C. §103

The Examiner has rejected dependent claims 5-6, 8, 11-13, 16-17 and 21-25 under 35 U.S.C. §103(a) as allegedly being unpatentable in view of Woiceshyn. As discussed above, Woiceshyn does not disclose or teach all of the elements recited in independent claims 1 and 14. Therefore, the Applicants respectfully assert that these claims are not obvious in view of Woiceshyn, since these dependent claims respectively depend from amended independent claims 1 and 14.

In addition, Woiceshyn teaches away from providing physical contact between the first and second layers of fiber materials, as recited in amended claims 1 and 14. As discussed above, there is no suggestion for the first and third layers in Woiceshyn to be in physical contact because it would frustrate the primary use or purpose of Woiceshyn, which is to provide a reinforced bituminous roofing membrane, with reinforcement being provided by Woiceshyn's intermediate layer. As discussed in Woiceshyn, the first layer 1 is combined with a second layer 5 reinforcing fabric (Col. 3, lines 13-17 and Abstract) before being combined with a third layer 12 fiberglass mat. In fact, the second reinforcing fabric layer 5 is essential to Woiceshyn's reinforced bituminous roofing membrane for the reasons discussed above. Accordingly, there is no motivation or suggestion to remove the second layer 5 material from Woiceshyn's reinforced bituminous roofing membrane.

Furthermore, the Examiner states that properties for the disclosed material recited in rejected claims are not explicitly taught by Woiceshyn, but that such claimed properties are still obvious in view of Woiceshyn. However, the Applicants respectfully request that, since the

Serial No. 10/726,461
Attorney Docket No. 24170759.2

Examiner admits Woiceshyn does not explicitly teach these limitations, the Examiner point to a specific teaching or basis to support the rationale for rejecting these claims as obvious. The Applicants respectfully assert that the burden of initially establishing a *prima facie* case of obviousness still rests with the Examiner. As a result, the Examiner offers no scientific basis or rationale to support the assertion that the claimed properties would automatically result from use of the materials and structures disclosed in Woiceshyn, and a mere statement to that effect is not sufficient. To accept such an assertion is to say that the claimed properties are necessarily present in Woiceshyn's materials and structures when no proof to that effect has been provided or cited. M.P.E.P. 2144.02-2144.03.

For at least these reasons, Woiceshyn does not teach or suggest all of the elements of amended independent claims 1 and 14, from which the rejected dependent claims 5-6, 8, 11-13, 16-17 and 21-25 respectively depend, and a *prima facie* case of obviousness of all of the rejected claims has not been presented. Thus, the Applicants respectfully request that the Examiner withdraw the §103(a) rejections.

III. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that pending claims 1-25 are in condition for allowance, and request a Notice of Allowability for the pending claims. The Examiner is invited to contact the undersigned Attorney of Record if such would expedite the prosecution of the present Application.

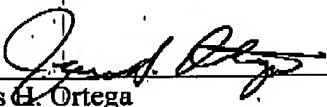
This Amendment was originally filed in response to a Final Rejection, within the three-month deadline, and thus no fees were due at the original time of filing. However, this Amendment was not entered at its original time of filing on March 14, 2005, and an Advisory Action was issued. In response to the Advisory Action, the Applicants filed an Request for

Serial No. 10/726,461
Attorney Docket No. 24170759.2

Continued Examination on April 14, 2005, and requested that this Amendment be entered along with the RCE. In response to the RCE, the pending Notice of Non-Compliant Amendment was mailed on April 22, 2005. Since this revised Amendment in response to the Notice of Non-Compliant Amendment is within the one-month deadline for response (Monday, May 23, 2005), no fees are believed to be due at this time. However, if it is determined that any fees are required, the Commissioner is authorized to charge those fees to Account No. 13-0480, referencing Attorney Docket No. 24170759.2.

Respectfully submitted,

Date: 5/23/2005


James G. Ortega
Reg. No. 50,554
Attorney for Applicant
BAKER & MCKENZIE LLP
2001 Ross Avenue, Suite 2300
Dallas, TX 75201
Tel: (214) 978-3058
Fax: (214) 978-3099

BEST AVAILABLE COPY